

II. REMARKS

Claims 1-19 are pending in this application. Claims 8-19 are withdrawn from consideration. Claims 1-7 are under examination and stand rejected. No amendments are requested.

**III. THE REJECTIONS UNDER 35 U.S.C. § 103
OVER BARKER IN VIEW OF FORTE**

Claims 1-7 stand rejected under 35 U.S.C. § 103 (a) over U.S. Patent No. 6,291,097 (issued Sept. 18, 2001) to J. Barker *et al.* (the “Barker”) in view of U.S. Patent No. 6,071,651 (issued June 6, 2000) to D.A. Forte *et al.* (“Forte”).

The Examiner contends that Barker shows and electrochemical cell “system” composed of a polymer matrix system. Office Action at p. 2. The Examiner admits that Barker does not show matted fiber paper. The Examiner contends, however, that Forte discloses a separator between electrode plates composed of mats or papers of glass fibers. The Examiner further makes the unsupported statement that it would have been obvious to combine the teachings of Barker and Forte because the “secondary reference materials are shown to be equivalent to those of the materials of the primary reference . . .”. Office action at pp. 2-3.

This rejection should be withdrawn because there is no motivation to combine Barker and Forte with respect to incorporating a matted fiber paper comprising cellulose in the battery disclosed by Barker.

Furthermore, to support obviousness, a reference must suggest to one of ordinary skill in the art that the claimed invention could be carried out with a reasonable likelihood of success. Both the suggestion and the expectation of success must be founded in the prior art. In re Dow Chem. Co., 837 F.2d 469, 472 (Fed. Cir. 1988).

To support an obviousness rejection based on a reference combination, there must be a reason, suggestion, or motivation to combine the references. “[T]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination, that knowledge cannot come from applicant’s invention itself”. In re Oetiker, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992); see also; MPEP 2143.01. I

It is the Examiner’s burden to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that the skilled artisan,

confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1993).

The Examiner has made a completely unsupported allegation that it would be obvious to combine Barker and Forte and, therefore, has not met his burden. Forte is directed to matted glass separators as opposed to Applicant's claims which are directed to cellulose papers. For example, Forte's specification recites the following:

The resilient separator media are made from mats (preferably binderless) of air laid, randomly oriented, entangled microfibers, preferably glass microfibers. In addition to their resilience, the microfiber mats of the separator media of the present invention exhibit good integrity, are flexible and have an absence of openings passing directly through the mats between the major surfaces of the mats.

FORTE at col 3, lines 3-10. Accordingly, Forte provides no motivation to use cellulosic fiber mats with the matrix polymers disclosed by Barker. As discussed in Applicant's Specification, while cellulosic fiber separator members are attractive because of low cost, they are not employed in electrochemical cells because they are not known to bond well to cell electrode compositions. Attempts to counter this weakness by application of supplemental adhesive compounds have failed because the supplemental adhesives clog the natural porosity of the cellulose. APPLICANT'S SPECIFICATION at p. 2 line 30 through p. 3, line 8. In no portion of Barker or Forte is it even suggested that efficient binding of cellulosic mats can be achieved by use of Applicant's matrix polymer system. Accordingly, there is no motivation to combine the references. If the Examiner disagrees, Applicant's respectfully request the Examiner identify with specificity the motivation to combine Barker with Forte to obtain Applicant's claimed invention.

IV. THE REJECTIONS UNDER 35 U.S.C. § 103 OVER GOZDZ

In an Office Action mailed February 6, 2004, claims 1-7 were rejected under 35 U.S.C § 103/102(e) over U.S. Patent No. 5,552,239 (issued Sept. 3, 1996) to A. S. Gozdz *et al.* (the "'239 Patent") in view of U.S. Patent No. 6,306,539 (issued Oct. 23, 2001) to G. C. Zguris *et al.* ("Zguris").

In the Reply to this Office Action filed May 26, 2003, Attorney for Applicant argued that the '239 patent is not prior art under of 35 U.S.C. § 103(c). Attorney for Applicant withdraws

this contention. The benefit of the statute 35 U.S.C. § 103(c) does not apply to the '239 patent because it is available as prior art under 35 U.S.C. 102(b). Accordingly, the '239 patent can be used as prior art against the current application.

Nonetheless, the combination of the '239 patent with Zguris does not render Applicant's claims obvious because there is no motivation to combine the references.

In the Office Action mailed February 6, 2004, the Examiner has admitted that the '239 Patent does not disclose "matted fiber paper separator member" as claimed by Applicant. OFFICE ACTION, Mailed February 6, 2004, at p. 3. While it is alleged that the '239 patent discloses cell electrodes composed of a matrix polymer, there is absolutely no teaching or suggestion cited in the prior art that cellulosic separator members could be laminated to matrix polymer cell electrodes.


As discussed in Applicant's Specification, while cellulosic fiber separator members are attractive because of low cost, they are not employed in electrochemical cells because of binding inefficiencies. APPLICANT'S SPECIFICATION at p. 2 line 30 though p. 3, line 8. In no portion of the cited art is it even suggested that efficient binding of cellulosic mats can be achieved by use of Applicant's matrix polymer system. Therefore, there is no motivation to combine the references.

In view of the above discussion, Applicant's respectfully request withdrawal of the obviousness rejections and allowance of the claims.

V. CONCLUSION

In view of the above remarks and amendments, Applicant has overcome all rejections, and reconsideration is requested. No fee is required for entry of this Reply. If any fee is due, however, please charge the required fee to deposit account number 501358.

Respectfully submitted,



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